

Appln. No. 10/710,923
Docket No. 158982 / GEM-0053-P

REMARKS / ARGUMENTS

The Examiner comments that this action is made final because this application is a continuation-in-part of Applicant's earlier Application No. 10/065,595, and that all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application.

Applicant respectfully disagrees that this action can be properly finally rejected for the following reasons.

First, Applicant submits that this invention is not drawn to the same invention claimed in the earlier application as the earlier application is not drawn to "wherein said operator interface system comprises computer executable instructions stored in a memory *for using the volume of cardiac image data and the at least one viewable image in...*, and *in location and navigation of an interventional tool.*" While Applicant has herein amended Claim 1 to more clearly describe the claimed invention, Applicant submits that the scope of the invention has not changed, and that the scope of this invention is not presented in the earlier application. Thus, the claims of this application are not drawn to the same invention claimed in the earlier application.

Second, Applicant submits that the office action dated June 8, 2007, in the earlier application was a non-final office action that did not include any grounds of rejection under 35 U.S.C. §102(e) or 35 U.S.C. §103(a), and did not include any art of record relied upon (no prior art rejections made), and more specifically did not include the art of record now relied upon. As such, if the claims of this application had been entered in the earlier application, it appears that the Examiner would have relied upon other grounds and not the grounds relied upon, and would have relied upon other art and not the art of record (no art of record relied upon), in the June 8, 2007, office action of the earlier application. Thus, this application could not have been finally rejected *on the grounds and art of record* in the next Office Action if they had been entered in the earlier application.

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If the Examiner maintains that the claims of this application are drawn to the same invention claimed in the earlier application, then Applicant submits that such a position would merely serve to reinforce Applicant's second reason stated above, as any new grounds of rejection in the earlier application could not have been attributed to the entering of the subject claims in the earlier application.

In view of the foregoing, Applicant submits that the finality of this office action is premature, and respectfully requests withdrawal thereof.

Status of Claims

Claims 1-45 are pending in the application. Claims 14-45 have been withdrawn from consideration by the Examiner. Claims 1-13 stand rejected. Applicant has amended Claim 1, and has withdrawn Claims 14-45, leaving Claims 1-13 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised of the position by the final rejection, which Applicant respectfully submits is premature.

Objections to the Specification

The specification is objected to for reasons relating to informalities and antecedent support.

Applicant has amended the specification as set forth above to address all reasons for this objection. No new matter has been added as antecedent support can be found in the application as originally filed, such as the originally filed claims for example.

Accordingly, Applicant requests reconsideration and withdrawal of these objections, which Applicant considers to be overcome.

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Rejections Under 35 U.S.C. §102(e)

Claims 1-13 stand rejected under 35 U.S.C. §102(e) as being anticipated by Okerlund et al. (US 2003/0187358, hereinafter Okerlund).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the *** claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Claim 1 recites, inter alia,

“wherein said operator interface system comprises computer executable instructions stored in a memory for using the volume of cardiac image data and the at least one viewable image in..., and in location and navigation of an interventional tool.”

Here, Applicant is claiming an imaging system that includes an operator interface that uses a volume of cardiac image data and a viewable image for location and navigation of an interventional tool in a medical intervention planning procedure.

Dependent claims inherit all of the limitations of the respective parent claim.

In alleging anticipation, the Examiner looks to Figure 1 and Paragraphs [0017]-[0021] of Okerlund for support thereof.

In comparing Okerlund as referenced or otherwise with the claimed invention, Applicant finds Okerlund to disclose the use of an interventional system, but to be silent

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on the disclosure of an operator interface system having computer executable instructions stored in a memory for using a volume of cardiac image data and at least one viewable image in location and navigation of an interventional tool, as claimed.

Absent anticipatory disclosure of each and every element arranged as claimed, Okerlund cannot be anticipatory.

In view of the foregoing, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(e) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kcidar (US 6,650,927, hereinafter Kcidar) in view of Subramanyan et al. (US 6,782,284, hereinafter Subramanyan) and further in view of Chen et al. (WO 96/10949, hereinafter Chen).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Claim 1 recites, inter alia,

"wherein said operator interface system comprises computer executable instructions stored in a memory for using the volume of cardiac image data and the at least one viewable image in..., and in location and navigation of an interventional tool."

Dependent claims inherit all of the limitations of the respective parent claim.

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In alleging obviousness, the Examiner acknowledges that Keidar fails to disclose the claimed operator interface, and looks to the user interface (44) of Subramanyan to cure this deficiency. Paper No. 20071130, pages 4-5.

Applicant respectfully disagrees that Subramanyan cures the deficiencies of Keidar.

In comparing the combination of references with the claimed invention, Applicant finds the Subramanyan user interface (44) to include a computer and vessel tracker software component (40) (Subramanyan, col. 4, lines 12-13), but to be absent any disclosure, suggestion or teaching of executable instructions for using the volume of cardiac image data and the at least one viewable image in location and navigation of an interventional tool, as claimed. Applicant further submits that a vessel tracker software component is substantially different from an interventional tool location and navigation software component, and therefore cannot be applied to establish a prima facie case of obviousness.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to recognize a problem recognized and solved only by the present invention (location and navigation of an interventional tool), fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs (location and navigation of an interventional tool), and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

Applicant has amended the claims for presentation in a better form that more clearly reflects Applicant's invention. Notwithstanding Applicant's earlier remarks

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regarding the premature nature of the finality of this office action, Applicant submits that the claim amendments presented herein should require only a cursory review by the Examiner as they include language having the same scope as presented in the originally filed claims.

In light of the foregoing, Applicant respectfully submits that the proposed amendments and arguments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. §102(c) and 35 U.S.C. §103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any remaining issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

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In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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